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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Letts et al**

Application No: **10/718,060**

Group Art Unit: **1626**

Filed: **June 10, 2003**

Examiner: **Rebecca L. Anderson**

For: **Nitrosated and/or Nitrosylated Cyclooxygenase-2 Inhibitors, Compositions and Methods of Uses**

Attorney Docket No: **102258.157 US1**

Commissioner of Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**Provisional Response to Restriction Requirement and  
Request for Reconsideration of Restriction Requirement Under 37 C.F.R. § 1.143**

**I. Introductory Comments**

This response is submitted in reply to the Restriction Requirement dated December 13, 2005, for which a response is due on or before January 13, 2006.

No fee is believed to be due; however, the Commissioner is authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 08-0219 to maintain the pendency of the present application.

**II. Response to 37 C.F.R. § 1.132 Declaration**

The Examiner asserts that the 37 C.F.R. § 1.132 declaration by David S. Garvey, Ph.D. along with Applicant's arguments filed on October 19, 2005, does not provide evidence that the compound of Formula (V) is encompassed by the compounds of Formula (I). Additionally the Examiner asserts that the proviso on page 20 of the specification excludes the compound of Formula (V).

Applicants respectfully disagree with Examiner's assertion that the proviso on page 20 of the specification specifically excludes the compound of Formula (V). However in order to further prosecution Applicants will only address the Examiner's new restriction requirement.

### III. Request for Reconsideration of Restriction Requirement

Under 37 C.F.R. §1.143, Applicants respectfully request reconsideration of the restriction requirement dated December 13, 2005.

The Examiner restricted the invention as follows:

Group I	Claims 1-2, 53-55	Compounds and compositions of Formulas I, II-IV, VI-VIII and X-XVII
Group II	Claims 3-13	Methods of use for the compounds of Formula (I)
Group III	Claims 14, 15	Compositions of Formula I in combination with therapeutic agents
Group IV	Claims 16-26	Methods of use for compositions of Formula I
Group V	Claims 27-37, 57-66 <sup>1</sup>	Compositions of Formula I in combination with nitric oxide donor compounds
Group VI	Claims 38-48, 70-79	Methods of use for compositions of Group V
Group VII	Claims 49, 56	Kits for the compounds of Formulas I, II-IV, VI-VIII and X-XVII
Group VIII	Claims 50, 51, 52	Kits for the compounds of Formulas I in combination with NO donor compounds
Group IX	Claims 52	Kits for the compounds of Formulas I in combination with therapeutic agents
Group X	Claims 67, 68 <sup>1</sup>	Compositions of Formula I in combination with nitric oxide donor compounds and/or therapeutic agents
Group XI	Claims 69-79 <sup>1</sup>	Methods of use for compositions of Group X
Group XII	Claims 80, 81 <sup>1</sup>	Kits for the parent compounds of Formulas I in combination with NO donor compounds and/or therapeutic agents

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<sup>1</sup> Applicants would like to bring to the Examiner's attention that these claims 57-66, 67, 68, 69-79, 80 and 81 are drawn to the parent COX-2 inhibitors of Formulas (I) i.e. a COX-2 inhibitor compound that is not nitrosated and/or nitrosylated. The parent COX-2 inhibitors would include all the limitations of the compounds of Formulas (I) of claim 1 except that the variable Q must be a hydrogen atom.

Group XIII	Claims 54 and 55	Compounds and compositions of formulas V and IX
Group XIV	Claim 56	Kits for the compounds of Formula V or IX

The claims in the pending application are directed to:

- (i) compounds and compositions comprising **nitrosated and/or nitrosylated cyclooxygenase-2 inhibitor compounds of Formula (I)**, kits comprising the nitrosated and/or nitrosylated cyclooxygenase-2 inhibitor compounds, and the methods of use for the compounds and/or compositions; and
- (ii) compounds and compositions comprising **the parent cyclooxygenase-2 inhibitor compounds of Formula (I)**, kits comprising the parent cyclooxygenase-2 inhibitor compounds, and the methods of use for the compounds and/or compositions.

#### IV. Restriction is Not Proper When the Claims are Related

As stated in MPEP §808.02, “[w]here, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. §121 is never proper (MPEP §806.05).”

All the pending claims are related. Thus, the restriction requirement is not proper. To show that the inventions are distinct, the Examiner must show either that (1) there is a separate classification of the claims; (2) a separate status in the art when they are classifiable together; or (3) a different field of search. *In re Kase*, USPQ2d 1063 (USPTO Director, 2004).

None of these three criteria have been shown with the claims of this application.

If the nitrosated and/or nitrosylated cyclooxygenase-2 inhibitor compounds of Formulas I, II-IV, VI-VIII and X-XVII are allowable, then all the composition, kits and methods of use for these compositions would also be allowable. In other words, every pending claim that requires a **nitrosated and/or nitrosylated cyclooxygenase-2 inhibitor compound** of Formulas I, II-IV, VI-VIII and X-XVII would also be allowable. *In re Kase*, USPQ2d 1063 (USPTO Director, 2004).

A search of the prior art for the nitrosated and/or nitrosylated cyclooxygenase-2 inhibitor compounds of Formulas I, II-IV, VI-VIII and X-XVII (Group I) would necessarily encompass a search of the prior art for their compositions with additional agents, methods of use and the kits

comprising the compounds. Thus, the prior art for the nitrosated and/or nitrosylated cyclooxygenase-2 inhibitor compounds and products of Formulas I, II-IV, VI-VIII and X-XVII of Group I, will also be the same prior art for compositions of Formulas I, II-IV, VI-VIII and X-XVII with other agents (i.e. Groups III, V, X), their methods of use (i.e. Groups II, IV, VI), and the kits for the compositions comprising the nitrosated and/or nitrosylated cyclooxygenase-2 inhibitor compounds (i.e., Groups VII, VIII, IX).

If the parent cyclooxygenase-2 inhibitor compounds and compositions are allowable, then all the kits and methods of use for these compositions would also be allowable. In other words, every pending claim that requires a **parent cyclooxygenase-2 inhibitor compound** of Formula (I) would also be allowable. *In re Kase*, USPQ2d 1063 (USPTO Director, 2004).

A search of the prior art for the parent cyclooxygenase-2 inhibitor compounds and compositions would necessarily encompass a search of the prior art for their methods of use and the kits comprising the compounds. Thus, the prior art for the parent cyclooxygenase-2 inhibitor compounds and compositions of Groups V (in part) and X of Formula I, respectively, will also be the same prior art for their methods of use and kits for the compositions comprising the parent cyclooxygenase-2 inhibitor compounds (i.e., Groups XI, XII ).

If the cyclooxygenase-2 inhibitor compounds of Formula V and IX are allowable, then all the kits comprising these compounds would also be allowable. In other words, every pending claim that requires a cyclooxygenase-2 inhibitor compound of Formula V and IX would also be allowable. *In re Kase*, USPQ2d 1063 (USPTO Director, 2004).

A search of the prior art for the cyclooxygenase-2 inhibitor compounds of Formula V and IX would necessarily encompass a search of the prior art for the kits comprising these compounds. Thus, the prior art for the cyclooxygenase-2 inhibitor compounds of Formula V and IX (i.e. Group XIII), will also be the same prior art for the kits comprising these compound (i.e., Group XIV).

**V. Proposed restriction requirement**

Applicants respectfully propose the following restriction requirement:

Group I	Claims 1-56	Compounds, compositions, kits and methods of use for nitrosated and/or nitrosylated COX-2 inhibitor of Formula I, II-IV, VI-VIII and X-XVII
Group II	Claims 57-81	Compounds, compositions, kits and methods of use for <u>parent</u> COX-2 inhibitor of Formula I
Group III	Claims 55-56 (in part)	Compounds and kits comprising the COX-2 inhibitors of Formula V and IX

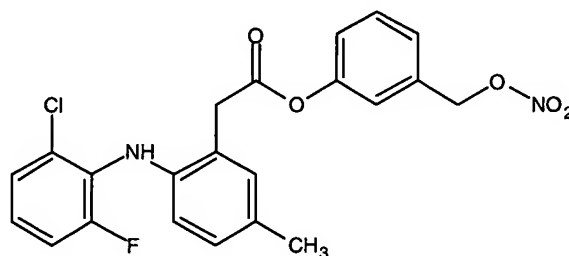
**VI. Provisional Response to Restriction Requirement**

Applicants provisionally elect Group I, claims 1-2, 53-55 drawn to the nitrosated and/or nitrosylated compounds and compositions of Formula I, Formula II-IV, VI-VIII and X-XVII with traverse.

**VII. Election of Species**

In response to the election of species requirement, Applicants elect the nitrosated cyclooxygenase inhibitor compound of Formula IV, 3-((nitroso)methylphenyl) 2((2-chloro-6-fluorophenyl) amino)5- methylphenyl)acetate, with traverse.

This compound has the structure:



(IV)

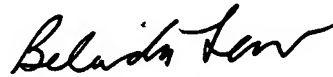
The compound is disclosed in the specification at page 23, lines 9-14.

**VIII. Conclusion**

Applicants respectfully request that the restriction requirement be withdrawn and be replaced with Applicant's proposed restriction requirement.

An early and favorable consideration and allowance of the pending claims is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Belinda M. Lew". The signature is fluid and cursive, with the first name "Belinda" being more prominent than the last name "Lew".

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Dated: January 12, 2006  
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